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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re patent application of: ) Date: June 21, 2004  
Douglas B. Quine ) Attorney Docket No.: F-176  
Serial No.: 09/629,909 ) Customer No.: 00919  
Filed: July 31, 2000 ) Group Art Unit: 2141  
Confirmation No.: 5067 ) Examiner: Djenane M. Bayard  
Title: SYSTEM AND METHOD FOR FORWARDING ELECTRONIC  
MESSAGES

**TRANSMITTAL OF APPEAL BRIEF (PATENT APPLICATION 37 CFR 1.192)**

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Transmitted herewith in **triplicate** is the **APPEAL BRIEF** in the above-identified patent application with respect to the Notice of Appeal filed on April 21, 2004.

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Respectfully submitted,

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Date



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of:

)Attorney Docket No.: F-176

Douglas B. Quine

)Group Art Unit: 2141

Serial No.: 09/629,909

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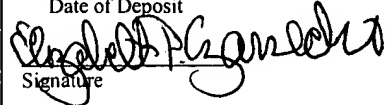
Title: SYSTEM AND METHOD FOR FORWARDING ELECTRONIC MESSAGES

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**APPELLANTS' BRIEF ON APPEAL**

Sir:

This is an appeal pursuant to 35 U.S.C. § 134 and 37 C.F.R. §§ 1.191 et seq. from the final rejection of claim 13 of the above-identified application mailed January 23, 2004. The fee for submitting this Brief is \$330.00 (37 C.F.R. § 1.17(c)). Please charge Deposit Account No. **16-1885** in the amount of \$330.00 to cover these fees. The Commissioner is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. **16-1885**. Enclosed with this original are two copies of this brief.

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**I. REAL PARTY IN INTEREST**

The real party in interest in this appeal is Pitney Bowes Inc., a Delaware corporation, the assignee of this application.

**II. RELATED APPEALS AND INTERFERENCES**

There are no appeals or interferences known to Appellants, their legal representative, or the assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

**III. STATUS OF CLAIMS**

The instant application was filed with claims 1-9. In the Preliminary Amendment dated August 5, 2002, claims 1-9 were canceled in favor of newly added claims 10-24. In the amendment dated December 9, 2003, claims 23 and 24 were canceled and claims 10, 14, 17, 21 and 22 were amended. Accordingly, claims 10-22 are currently pending with claims 10, 14, 17, 21 and 22 being independent.

Pursuant to the Final Office Action dated January 22, 2004, the claims stand rejected as follows:

- A. Claims 10, 13, 14, 17 and 20-22 stand rejected under 35 USC 103 as being obvious in view of U.S. Patent No. 6,438,583 to McDowell et al. (the '583 patent) in further view of U.S. Patent No. 6,075,844 to Goldberg et al. (the '844 patent);
- B. Claims 11, 15 and 18 stand rejected under 35 USC 103 as being obvious in view of the '583 patent in further view of U.S. Patent No. 6,014,688 to Venkatraman et al. (the '688 patent); and
- C. Claims 12, 16 and 19 stand rejected under 35 USC 103 as being obvious in view of the '583 patent in further view of U.S. Patent No. 6,405,243 B1 to Nielsen (the '243 patent).

#### **IV. STATUS OF AMENDMENTS**

There are no amendments to the claims filed subsequently to the final rejection dated January 22, 2004. Therefore, the claims as set forth in Appendix A to this brief are those as set forth before the final rejection.

#### **V. SUMMARY OF INVENTION**

The claims of the instant application relate to a method for forwarding an e-mail message intended to be delivered to a first e-mail address to a second e-mail address in the event the first e-mail address is disfavored. An e-mail forwarding computer is located at a third e-mail address, separate and apart from the sender's and intended recipient's computer, which e-mail forwarding computer is programmable to associate disfavored e-mail addresses with forwarding e-mail addresses.

In operation, a user at a user's computer sends an e-mail message to an e-mail address associated with an intended recipient. And if this e-mail address is disfavored (e.g., it is no longer a valid e-mail address), it is caused to be returned back to the user's computer. In order to find a favored address for the intended recipient (e.g., a valid e-mail address for the intended recipient), the user resends the e-mail from the user's computer to a remote e-mail forwarding computer (e.g., a second computer) that is separate and apart from both the user's and intended recipient's computer. Upon receipt of this e-mail message at the e-mail forwarding computer, the e-mail forwarding computer parses the disfavored e-mail address from the e-mail message to determine if there is a favored e-mail address stored in the e-mail forwarding computer that is associated with the disfavored e-mail address. If there is a favored e-mail address (e.g., a forwarding e-mail address) associated with the disfavored e-mail address, the remote e-mail forwarding computer (e.g., second computer) sends the e-mail message to the intended recipient's computer associated with the favored e-mail address.

Thus, an advantage of the present invention is that there is no cooperation needed by the e-mail server associated with the disfavored e-mail address. That is, if an e-mail address becomes disfavored (e.g., it is no longer an active e-mail address) either because the associated e-mail server ceases to exist, or the e-mail account has been left abandoned for a host of reasons, the present invention e-mail forwarding system nevertheless operates because no cooperation is

needed from the later e-mail server. An additional benefit is that when an e-mail message is forwarded by the present invention, the privacy of the recipient is protected because the sender of the e-mail message may not be notified of the recipient's forwarding address.

## VI. ISSUES

The sole issue on appeal is whether the subject matter defined in independent claims 10, 14, 17, 21 and 22 is rendered obvious in view of the '583 patent in further view of the '844 patent.

## VII. GROUPING OF CLAIMS

Claims 10-22 are grouped as Group I.

All the claims in Group I stand and fall together.

## VIII. ARGUMENT

As Appellant discusses in detail below, the final rejection of claim 13 is devoid of any factual or legal premise that supports the position of unpatentability. It is respectfully submitted that the rejection does not even meet the threshold burden of presenting a prima facie case of unpatentability. For this reason alone, Appellants are entitled to grant of a patent. In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

A. The subject matter defined by claims 10, 14, 17, 21 and 22 is not rendered obvious by the combination of the '583 patent with the '844 patent.

In formulating the argument, reference is first made to independent claim 10, which recites the following:

A method for transmitting an e-mail message intended for a non-preferred e-mail address to a preferred e-mail address, the method comprising the steps of:

receiving the e-mail message at a second address, the e-mail message having been previously rejected at the non-preferred e-mail address and transmitted back to a sender address;

parsing the non-preferred e-mail address from the e-mail message at the second address and determining if there is a preferred e-mail address associated with the non-preferred e-mail address; and

sending the e-mail message from the second address to the preferred e-mail address.

Thus: 1) an email is transmitted from a sender's address; 2) rejected at a non-preferred PC; 3) send back to the senders address; and then 4) sent to a second address for e-mail forwarding services. Independent claims 14, 17, 21 and 22 recite similar recitations.

In formulating the 35 U.S.C. 103 rejection of the '583 patent in view of the '844 patent, the examiner states: "[the 583 patent] fails to teach wherein the e-mail message having been previously rejected at the non-preferred e-mail address and transmitted back to the sender address." The examiner then applies the '844 patent to teach this recitation with references to col. 7, lines 30-38 and col. 7, lines 11-12 of the '844 patent.

It is respectfully submitted that the '844 patent does not overcome the admitted deficiencies of the '583 patent. A proper reading of the '844 patent reveals that it neither teaches nor suggests processing a rejected e-mail that was returned from a recipient's PC. For instance, with respect to col. 7, lines 11-12 of the '844 patent, what is actually taught is that when a sender's PC sends a message to a recipient, it also sends a message back to the sender "so the sender is able to determine whether the message was correctly sent to the intended recipient." In other words, did the sender's PC correctly identify who the intended recipient is. This has nothing to do with processing an e-mail message "at a second address" for an "e-mail message having been previously rejected at the non-preferred e-mail address." Similarly, with respect to col. 7, lines 30-38 of the '844 patent, what is actually taught is that the system sends a message back to the sender that it "is not able to determine who the recipient for the message is because either the speech recognition software could not recognize the identification information . . . or no routing access code was contained in the database for the intended recipient . . ." Again, this clearly does not teach or suggest of processing an e-mail message at a "second address" that determines if there is a favored e-mail address for forwarding that e-

mail message. In other words, there is no teaching or suggestion of a "second address" in the '844 patent that processes e-mail messages having a disfavored e-mail address.

For these reasons, the '844 patent does not teach or suggest of processing rejected previously transmitted e-mail messages at a second address and thus does not overcome the noted shortcomings of the '583 patent. Accordingly, it is submitted that independent claims 10, 14, 17, 21 and 22 are allowable over the '583 patent in combination with the '844 patent.

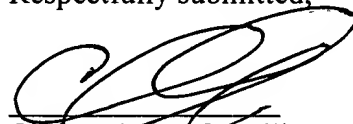
With regards to remaining claims 11 13, 15, 16 and 18-20, since each of these claims depend respectively from either of independent claims 10, 14, 17, 21 and 22 as addressed above, they are likewise allowable over the cited art of record since neither the '688 or '243 patent overcome the noted deficiencies of the '583 patent in processing rejected previously transmitted e-mail messages at "a second computer."

For at least the above reasons, Appellant respectfully submit that the final rejection of claims 10-22 is in error and should be reversed.

#### **IX. CONCLUSION**

In Conclusion, Appellants respectfully submit that the final rejection of claims 10-22 is in error for at least the reasons given above and should, therefore, be reversed.

Respectfully submitted,



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## APPENDIX A

10. A method for transmitting an e-mail message intended for a non-preferred e-mail address to a preferred e-mail address, the method comprising the steps of:

receiving the e-mail message at a second address, the e-mail message having been previously rejected at the non-preferred e-mail address and transmitted back to a sender address;

parsing the non-preferred e-mail address from the e-mail message at the second address and determining if there is a preferred e-mail address associated with the non-preferred e-mail address; and

sending the e-mail message from the second address to the preferred e-mail address.

11. The method as recited in Claim 10, further comprising the step of sending an e-mail message to the sender address from the second address indicating that the e-mail has been sent to the preferred e-mail address.

12. The method as recited in Claim 10, further comprising the step of sending an e-mail message to the sender address from the second address indicating that the e-mail message was not forwarded to the preferred e-mail address if the preferred e-mail address is not associated with the non-preferred e-mail address.

13. The method as recited in Claim 10, wherein the parsing step further comprises the step of comparing the non-preferred e-mail address to a look-up table to determine if the non-preferred e-mail address is contained in the look-up table.

14. A method for transmitting an e-mail message comprising the steps of:

receiving an e-mail message at a second address, the e-mail message having been previously rejected at the non-preferred e-mail address and transmitted back to a sender address, the e-mail message including non-preferred e-mail address data associated with a desired recipient;

parsing the e-mail message to obtain the non-preferred e-mail address data from the e-mail message;

determining a preferred e-mail address from the non-preferred e-mail address data; and

sending the e-mail message from the second address to the preferred e-mail address when the preferred e-mail address has been established.

15. The method as recited in Claim 14, further comprising the step of sending an e-mail message to a sender address from the second address indicating that the e-mail has been sent to the preferred e-mail address.

16. The method as recited in Claim 14, further comprising the step of sending an e-mail message to a sender address from the second address indicating that the e-mail message was not forwarded to the preferred e-mail address if the preferred e-mail address is not determined.

17. A method for transmitting an e-mail message that has been sent from a sender address to a previously-known recipient e-mail address and rejected at the previously-known recipient e-mail address, and transmitted back to the sender address, the method comprising the steps of:

receiving the rejected e-mail message at a second address;

determining a preferred recipient e-mail address from the rejected e-mail message; and

sending the e-mail message from the second address to the preferred recipient e-mail address when the preferred recipient e-mail address has been determined.

18. The method as recited in Claim 17, further comprising the step of sending an e-mail message to the sender address from the second address indicating that the e-mail has been sent to the preferred recipient e-mail address.

19. The method as recited in Claim 17, further comprising the step of sending an e-mail message to the sender address from the second address indicating that the e-mail message was not forwarded to the preferred recipient e-mail address if the preferred recipient e-mail address is not determined.

20. The method as recited in Claim 17, further comprising the step of comparing the previously-known recipient e-mail address to a look-up table to determine if the previously-known recipient e-mail address is contained in the look-up table.

21. A method for transmitting an e-mail message that was sent from a sender address to a previously-known recipient e-mail address that is associated with a first service provider, and rejected at the previously-known recipient e-mail address, and was sent back to the sender address, the method comprising the steps of:

receiving the rejected e-mail message at a second address;

determining a preferred recipient e-mail address, that is associated with a second service provider, from the rejected e-mail message; and

sending the e-mail message from the second address to the preferred recipient e-mail address when the preferred recipient e-mail address has been determined.

22. A method for transmitting an e-mail message that , was previously rejected at a non-preferred e-mail address and transmitted back to a sender address and then sent from a sender address to a second address, the e-mail message including non-preferred e-mail address data associated with a first service provider and a desired recipient comprising the steps of:

receiving the e-mail message at the second address;

parsing the e-mail message to obtain the non-preferred e-mail address data from the e-mail message;

determining a preferred e-mail address, that is associated with a second service provider, from the non-preferred e-mail address data; and

sending the e-mail message from the second address to the preferred e-mail address when the preferred e-mail address has been established.